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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,952	08/03/2001	Hiroshi Satomi	B422-167	8387

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EXAMINER	
ESCALANTE, OVIDIO	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/921,952	SATOMI ET AL.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on October 26, 2005. **Claims 61-86** are now pending in the present application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2005 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 86 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

5. Claim 86, claims the non-statutory subject matter of a program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed program is not tangibly embodied in a physical

medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 61-66,68-74,76-83,85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. US Patent Pub. 2001/0039560 in view of Mousseau et al. US Patent Pub. 2001/0005864.

Regarding claim 61, 70, 78-80 and 85, Uchida teaches an information providing system, method, program product and storage medium holding a control program for a computer to execute a method of operating an information providing system (abstract) comprising:

an information providing apparatus (mail server 100 - fig. 2) comprising:

receiving means adapted to receive electronic mail information, (paragraphs 0070 and 0074);

registering means adapted to register the electronic mail information in correspondence with code information in a database (Access code storage unit 143 - fig. 2), (paragraphs 0074 and 0077); and

notifying means adapted to notify the code information corresponding to received electronic mail information to the destination device, (paragraph 0082),

an information output terminal comprising:

accepting means adapted to accept an input of the notified code information;

acquiring means adapted to acquire the electronic mail information based on the input code information, (paragraph 0082); and

outputting means adapted to output the acquired electronic information, (paragraph 0082).

Uchida does not specifically teach of determining means adapted to determine whether or not a destination device of said electronic mail can output the information.

In the same field of endeavor, Mousseau teaches determining means adapted to determine whether or not a destination device of said electronic mail information can display the electronic mail information, (paragraphs 0016,0034,0035,0042,0072 and 0073).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alterative device to view the received information if the users first device cannot view the received information.

Regarding claim 62, Uchida in view of Mousseau, as applied to claim 61, teaches wherein said output device is a printing apparatus, (paragraph 0035).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alterative device to view the received information if the users first device cannot view the received information.

Regarding claims 63 and 71, Uchida, as applied to claims 61 and 70, teaches wherein said outputting means also outputs the inputted code information, (paragraph 0082).

Regarding claims 64,72 and 82, Uchida, as applied to claims 61,70 and 80, teaches authenticating means adapted to authenticate a user of the destination device, wherein said registering means is operable to register the electronic mail information and the code information in accordance with an authentication result, (paragraphs 0074 and 0077).

Regarding claims 65 and 73, Uchida, as applied to claims 61 and 70, teaches wherein the electronic mail information includes a file attached to an electronic mail, (paragraph 0071).

Regarding claims 66,74 and 83, Uchida, as applied to claims 65,73 and 83, teaches wherein the attached field is an image data or an application data, (paragraph 0071).

Regarding claims 68 and 76, Uchida in view of Mousseau, as applied to claims 61 and 70, teaches second determining means adapted to determine whether or not an output device can output the received electronic mail information, (paragraphs 0016,0034,0035,0042,0072,0073).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of

said electronic mail can display the information as taught by Mousseau so that the user can select an alterative device to view the received information if the users first device cannot view the received information.

Regarding claims 69 and 77, Uchida in view of Mousseau, as applied to claims 61 and 70, teaches wherein said notifying means is further operable to notify that an output device can output the electronic mail information, (paragraphs 0073,0076,0078).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alterative device to view the received information if the users first device cannot view the received information.

Regarding claim 86, Uchida teaches a computer program for causing a computer to execute an information providing method set out in claim 85, (paragraph 0046,0078 and 0081).

9. Claims 67,75 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Mousseau and further in view of Watanabe US Patent Pub. 2001/0034226.

Regarding claims 67,75 and 84, Uchida in view of Mousseau, as applied to claims 67 and 70, do not specifically teach wherein said determining means effects said determining in accordance with whether the electronic mail information includes characters exceeding a predetermined number of characters.

In the same field of endeavor, Watanabe teaches of determining that the e-mail cannot be outputted in a destination if the maximum number of character is exceeded, (paragraphs 0050 and 0052).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mousseau by determining that the e-mail cannot be outputted if the maximum number of characters is exceed so that the user can be notified that there destination device cannot view the entire message.

Response to Arguments

Applicant's arguments filed October 26, 2005 have been fully considered but they are not persuasive.

Applicant contends that Uchida et al. or Mousseau et al. do not teach reference of "notifying code information corresponding to the received electronic mail information to the destination device if a result of the determining is that the destination device cannot output the electronic mail information." The Examiner respectfully disagrees.

While the Examiner agrees that Uchida does not teach that the notification of the access code information is not in response to "determining if the destination device cannot output the e-mail information,: the Examiner believes that Uchida provides sufficient suggestion for one of ordinary skill in the art to modify Uchida to include this feature as stated above in the rejection.

Uchida teaches and suggests of sending the code information to help save network resources and so that the destination device user can still access the full message. This reason is based on the suggestion that the sender does not want to send the full e-mail message to the destination device and hence suggests that the destination device cannot display the full e-mail message at the time that the sender wants sends the e-mail message.

Mousseau was relied upon since the information apparatus of Uchida did not determine the capabilities of each destination device.

Thus the Examiner believes that by using the feature of predetermining the capabilities of each device in Uchida one of ordinary skill would have sent the access code in cases in which the destination device cannot receive the entire message at the time that the message sender sent the message and thus will leave the downloading of the message at the discretion of the message recipient.

Conclusion

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Primary Patent Examiner
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February 3, 2006

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